



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,282	03/12/2004	Yoshihisa Usami	Q79893	6447

23373 7590 06/09/2006

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
----------	--------------

1774

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/798,282

Applicant(s)

USAMI ET AL.

Examiner

Betelhem Shewareged

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-19 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-19 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/8/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's response filed on 03/23/2006 has been fully considered. Claims 1, 7 and 9 are amended, claims 8 and 20 are canceled, and claims 1-7, 9-19 and 21-24 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 9-19 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paulson (US 6,051,306) in view of Kobayashi (US 2002/0176970 A1) and Fujii et al. (US 6,452,899 B1).

4. Paulson discloses an ink jet receiving medium comprising a substrate and an ink receiving layer on the substrate (claim 8). The substrate comprises CD-ROM and CD recordable (col. 3, line 17). The recording medium further comprises a white primer layer between the substrate and the ink receiving layer (col. 4, line 64 thru col. 5, line 19). The primer layer is equivalent to the claimed undercoat layer. With respect to the diffusion reflectance, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Paulson reference teaches all of Applicant's claimed

Art Unit: 1774

compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. Paulson does not teach ink receiving layer containing the claimed components.

5. Kobayashi teaches an ink jet recording sheet comprising a support and a colorant-receiving layer on the support (abstract). The colorant-receiving layer formed by: applying a first coating liquid having polyvinyl alcohol, silica and at least one of the compound represented by formula (1) and formula (2); applying, to the coat layer formed by the application of the first coating liquid, a second coating liquid, which includes a cross-linking agent such as boron compound and a mordant either at the same time as the application of the first coating liquid or during drying of the coat layer of the first coating liquid but before the coat layer shows a decreasing rate of drying ([0047]-[0050], [0054]-[0064], [0068], [0073], [0075], [0089], [0102] and [0131]). With respect to the surface gloss, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Kobayashi reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. The process by which the colorant-receiving layer is formed is not dispositive of the issue of the patentability of the instant article claims.

Art Unit: 1774

6. Paulson and Kobayashi are analogous art because they are from the same field of endeavor that is the ink jet recording medium art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the colorant receiving layer of Kobayashi with the invention of Paulson to provide an ink receiving layer that has good ink absorbability, and the layer does not shrink and crack ([0017] of Kobayashi).

7. Paulson does not teach a substrate having a recording layer as recited in the claimed invention.

8. Fujii teaches an information medium comprising, among other layers, a substrate (5) and a recording layer (12) (Fig. 1, and Fig. 2). The substrate (5) has a thickness of 0.6 ± 0.02 mm (col. 3, line 45). (NOTE: Substrate(5) has the same size as a substrate (1) (col. 5, line 40).

9. Paulson and Fujii are analogous art because they are from the same field of endeavor that is the optical information medium art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the information medium of Fujii with the invention of Paulson so as to provide an information medium having a high density recording and stable recording of the signals (col. 2, line 15 of Fujii).

Response to Arguments

10. Applicant's arguments with respect to claims 1-7, 9-19, and 21-24 have been considered but are moot in view of the new ground(s) of rejection.

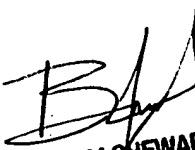
Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B.S.
June 1, 2006.


BETELHEM SHEWAREGED
PRIMARY EXAMINER